

REMARKS

I. Status of Claims

Claims 1-10, 12, 14-48 and 50-58 are pending with claims 1, 41 and 48 being independent. Applicants note with appreciation the indication that claims 41-48 and 50-58 have been allowed.

Applicants note with equal appreciation the indication that claims 4-10, 12 and 14-40 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, Applicants have opted to defer rewriting the above-identified claims in independent form pending consideration of the arguments presented below with respect to the rejected claims.

II. Response to Claim Rejections Under 35 U.S.C. §102(e)

Claims 1-3 were rejected under 35 U.S.C. § 102(e) as being anticipated over U.S. Patent No. 6,459,882 to *Palermo et al.* (hereafter referred to as PALERMO).

It is first noted that in the outstanding Office action, the anticipatory rejection of claims 1-3 consists, in its entirety, of a one paragraph verbatim recitation of the claim limitations ending with a citation to the entire written disclosure of PALERMO and a specific reference to FIG. 6. At the very least, Applicants have not been put on notice by the U.S. Patent and Trademark Office as to why they are not afforded a patent under 35 USC §102 - "A person is entitled to a patent unless:..." That is, the Examiner has not complied with 37 CFR §1.104(b)(2) by designating "as nearly as practicable" the parts of PALERMO that anticipate the instantly claimed invention. Again, the Examiner has merely cited to the entire PALERMO disclosure and thus violated Applicants' procedural due process rights which by itself warrants a new and revised Office action. However, in the interest of closing prosecution, Applicants have considered PALERMO and respectfully traverse the anticipatory rejections of claims 1-3.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. *Id.* "In addition, the prior art reference must be enabling." *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471,

1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). Such possession is effected only if one of ordinary skill in the art could have combined the disclosure in the prior art reference with his/her own knowledge to make the claimed invention. Id..

Regarding claim 1, the Examiner asserts that PALERMO discloses the claimed invention. Applicants respectfully disagree. Applicants have carefully considered PALERMO and submit that PALERMO does not disclose teach or suggest that:

based on magnitudes of the magnetic field signals received on the first transducer assembly, identifying a position in space of the first transducer assembly with respect to the second transducer assembly (emphasis added)

While PALERMO may disclose a first and second transducer assemblies that wirelessly communicate, PALERMO does not does not disclose teach or suggest identifying a position in space of the first transducer assembly, let alone identifying a position in space of the first transducer assembly with respect to the second transducer assembly. Moreover, PALERMO does not does not disclose teach or suggest that the identification of the position is based on magnitudes of the magnetic field signals received on the first transducer assembly. Accordingly, PALERMO fails to disclose teach or suggest each and every limitation of claim 1.

As stated in MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Therefore, is it respectfully submitted that claim 1 is allowable over PALERMO. Should the rejection of claim 1 be maintained, the Examiner is respectfully requested to articulate in detail how PALERMO is being interpreted to anticipate the above identified features of claim 1.

Regarding claims 2 and 3, these claims are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 2 and 3 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not disclosed, or even suggested, by PALERMO. For example, claim 2 recites that:

based on the magnitudes of the magnetic field signals received on at least two uniquely oriented transducers of the first transducer assembly, identifying an orientation of the first transducer assembly with respect to the second transducer assembly (emphasis added)

As discussed above, PALERMO may disclose a first and second transducer assembly that wirelessly communicates. However, PALERMO does not does not disclose teach or suggest identifying an orientation of the first transducer assembly, let alone identifying an orientation of the first transducer assembly with respect to the second transducer assembly. Moreover, PALERMO does not does not disclose teach or suggest that the identification of the orientation is based on magnitudes of the magnetic field signals received on at least two uniquely oriented transducers of the first transducer assembly. Accordingly, PALERMO fails to disclose teach or suggest each and every limitation of claim 2. Therefore, is it respectfully submitted that claim 2 is allowable over PALERMO. Should the rejection of claim 2 be maintained, the Examiner is respectfully requested to articulate in detail how PALERMO is being interpreted to anticipate the above identified features of claim 2.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1-3 be withdrawn.

III. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

It is believed that no additional fees are due in connection with the filing of this Amendment. However, please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-4100, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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